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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,377	04/11/2006	Osmo Suovaniemi	0933-0269PUS1	9078

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EXAMINER

GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1797

NOTIFICATION DATE	DELIVERY MODE
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08/17/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/575,377	Applicant(s) SUOVANIEMI ET AL.	
	Examiner Brian R. Gordon	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-7 in the reply filed on July 17, 2009 is acknowledged. The traversal is on the ground(s) that claim 8 has been amended to recite speeded up removal is achieved by secondary means. This is not found persuasive because the method of claim 8 does not require the specific device of claim 1 to perform the steps. The method can be performed by materially different apparatus furthermore the device is not limited to practicing the method of claim 8. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

As to claim 1, it is unclear what is meant by "speeded up emptying movement". For the purpose of examination, it is assumed that this means moving the plunger in a direction for dispensing.

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As to claim 2, there is no antecedent basis for the recitations of "the energy needed " and "the activation of said energy means".

The use of the phrase "the said" in the claims is redundant.

As to claim 3, it is unclear what structure defines "a mechanical response". Is this actual structure or the description of movements of components of the device.

As to claim 4, it is unclear what is being referenced by the pronoun "it's". Furthermore it is unclear what structure defines "magnetic characters". There is no antecedent basis for "the suction plunger". It is further unclear what is meant by the phrase "from it's other end the a function plunger directed to the upper part..." Furthermore it is unclear if the "a combination"; "a mechanical response"; and "a function" are structural elements. It appears as if the terms are directed to use or movement of components. The claim should be amended to clearly define structural components.

Claims 5-6 are not further limiting of claim 1. The claims do not add any further structure to device, but merely recite the name or classification by which applicant chooses to refer to the device. There are no electrical components claimed, no channels claimed, or any other structure recited to warrant the device being respectively classified as that as recited in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Berteloot et al., US 5,330,717.

Berteloot et al. discloses electropneumatic apparatus for sampling rapidly predetermined volumes of a mixture. The device is an injector 2 that comprises a rod 20 having an end inserted into the pipette 18 for ejecting the first reagent out of the pipette 18 by driving the rod 20 into the pipette 18. A piston device (plunger) is provided. It is mounted on top of the pipette holder 16. This piston device includes a piston cylinder 22 (cylinder in body), a piston 24 disposed inside the cylinder 22, and a return spring 26 (energy means) for biasing the piston 24 toward the rod 20. A pin 28 is provided for locking the piston 24 in a position where the return spring 26 is compressed, whereby a user can activate the injector 2 to eject the first reagent out of the pipette 18 into the reactor 4 by removing the pin 28 (secondary/locking/launch means).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berteloot et al. as applied to claims 1-2 and 5-7 above, and further in view of Rainin et al. US 6,352,673.

Berteloot et al. does not disclose a magnet as a locking means.

Rainin et al. discloses a pipette in which includes an iron or steel ring 113 secured to a top of the plunger 24 and a ring magnet 114 secured to an underside of a top of the pipette body 12 around the access opening for the upper portion 26 of the plunger unit 16. Thus constructed, as the plunger unit 16 approaches the upper stop 18, the magnetic field generated by the magnet 114 attracts the ring 113 to releasably secure the ring to the magnet and the plunger unit at the upper stop 18.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the device of Berteloot et al. may be modified to include the magnetic locking mechanism of Rainin et al. to secure the plunger at the upper position.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
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